

Notice of Allowability

Application No.

10/612,984

Examiner

Golam M M Shameem

Applicant(s)

NAKA ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 07/06/04.
2. ☒ The allowed claim(s) is/are 3,5-12,22-27,29-31,33 and 35 (now 1-20).
3. ☒ The drawings filed on 07 July 2003 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 07/687,238.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

Priority

This application is a divisional of 10/046,189 01/16/2002, now US 6,608,201 which claims benefit for foreign priority under 35 U.S.C. § 119(a)-(d) to Japan 113148-1990 04/27/1990; Japan 141942-1992 05/30/1990; Japan 208662-1990 08/06/1990; Japan 264579-1990 10/01/1990; Japan 413679-1990 12/24/1990; is acknowledged.

Status of Claims

Claims 3, 5-12, 22-27, 29-31, 33 and 35 are pending in the application.

Receipt is acknowledged of Applicant's amendment / response filed on July 06, 2004 and that has been entered. Claims 1, 2, 4, 13-21, 28, 32, 34 and 36 have been canceled. Claims 5-7, 10, 22-27, 29-31 and 33 have been amended.

Information Disclosure Statement

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 07/07/03, which has been entered in the file.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group I, (which includes claims 3, 5-12, 22-27, 29-31, and 33) with traverse and the elected species as set forth in compound of claim 35 (Remarks, on page 9), is acknowledged.

During a telephonic interview, with Mr. Matthew Mulkeen (Attorney for Applicant) on July 1, 2004, Applicant has agreed to cancel non-elected claims 4, 32 and 36. On the other hand, Examiner agrees to rejoin claim 35 with the elected Group I. Therefore, the requirement for restriction is still deemed proper and is therefore made FINAL.

Applicants preserve their right to file a divisional on the non-elected subject matter.

Reasons for allowance

The following is an examiner's statement of reasons for allowance:

Carini et al. (US 4,880,804, cited in IDS) teach the substituted benzimidazole derivatives, process for their preparation and methods using thereof. The instant method differs from the prior art, which comprises i) reacting a compound of formula (Io) with an alkylating agent to form an intermediate compound of formula (Ip) and subsequently ii) de-protecting the compound of formula (Ip) to obtain the desired product. The prior art method neither teaches nor renders obvious the instant claimed method and there is no suggestion or motivation to modify the methods of other prior art to obtain the instant method. Therefore the instant claims are allowable over the prior art of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Art Unit: 1626

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.



Golam M M Shameem, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1

July 15, 2004